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Technology Center 2100

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In re Application of: Kerzendorf, et al.)
Application No. 09/907,513) DECISION ON PETITION TO
Attorney Docket No. U 013457-4) WITHDRAW HOLDING OF
Filed: 17 July 2001) ABANDONMENT UNDER 37 CFR
For: SENSOR SYSTEM AND METHOD) §1.181
FOR DETERMINING SYSTEM STATES)

This is a decision on the petition filed June 6, 2005, to withdraw the holding of abandonment of the above-identified application, under 37 C.F.R. § 1.181.

The instant application became abandoned for failure to properly respond to the Office action (Final Rejection) mailed May 3, 2004. A Notice of Abandonment was mailed on March 15, 2005.

The Petition is **DENIED**.

Recent Prosecution History

On June 18, 2003, a Non-Final Office action was mailed, rejection all pending claims 1-8 under 35 USC 112 (2nd paragraph).

On October 23, 2003, an amendment was filed in response to the Non-Final Office action, canceling claims 1-8 and adding new claims 9-28.

On May 3, 2004, a Final Office action was mailed, rejecting claims 9-10, 13-20 & 23-28 on prior art, and indicating claims 11-12 & 21-22 to be objected to.

On September 7, 2004, an after final amendment and response was filed, including a partial translation of the foreign priority document (claims 1-11) as well as a signed statement of accuracy of the translation.

On November 3, 2004, an Advisory Action was mailed, denying entry of the after final amendment submitted Sept. 7, 2004 for failure to place the instant application in condition for allowance.

On March 15, 2005, a Notice of Abandonment was mailed.

On June 6, 2005, the instant petition was filed.

Relief Requested

The instant petition requests the following relief: 1) withdrawal of the finality of the May 3, 2004 Office action and corresponding entry of the after final amendment; and 2) withdrawal of the holding of Abandonment.

Analysis

1) The request for Withdrawal of the finality of the Office action mailed October 25, 2004 will be addressed first.

A petition under 37 CFR §1.181 must include: (1) a statement of facts involved and (2) the point or points to be reviewed and the action requested. *Note, the mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings.* In addition § 1.181(f) sets forth: *any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely.* Further, when a petition is taken from an action or requirement of an examiner in the ex parte prosecution of an application, ... it may be required that there have been a proper request for reconsideration (37 CFR §1.111) and a repeated action by the examiner.

The petition initially filed on June 6, 2005 includes elements (1) and (2) above. However, the petition was not filed within two months of the action (Advisory Action, mailed November 3, 2004) from which the relief is requested i.e. the Examiner maintaining his position in response to the request for reconsideration (of the propriety of the Final rejection of May 3, 2004).

Therefore, the request to withdraw the finality of the May 3, 2004 Office action is **DENIED.**

However, in order to clarify the prosecution record, a brief analysis will be proffered. Following a first Official action on the application, the Applicant submitted an amendment canceling all the original claims and presenting new claims for examination. Pursuant to the amendment, the Examiner made the next action final, which was mailed on May 3, 2004.

In Applicant's after final response, dated September 7, 2004, Applicant submitted an amendment to the claims that the Examiner observed in accordance with 37 C.F.R. § 1.116 and thus determined that the response was not admissible. In the Advisory Action, dated November 3, 2004, the Examiner indicated, inter alia, that the amendment to claim 9 did not comport with the criteria for admission of an amendment After Final by raising new issues and considerations. Thus, as indicated by the Examiner in the Advisory Action, Applicant's response, dated September 7, 2004, did not satisfy the After Final practice under 37 C.F.R. § 1.116 for entry of the response by placing the application clearly in condition for allowance.

Since Applicant's amendment, dated September 7, 2004 was not entered as it did not comply with the conditions for admission After Final, it therefore, precluded consideration of the arguments regarding the priority issue, as part of Applicant's September 7, 2004 submission (that was denied entry).

It is noted that in the Advisory Action mailed November 3, 2004, unfortunately, the Examiner erroneously made reference to a set of claims 1-11, which were from Applicant's foreign filing and irrelevant to the instant issue. The Office regrets the Examiner's allusion to the set of claims 1-11, however, this extraneous reference does not vitiate the substance and propriety of the Advisory Action. The communication indicates that the Examiner did review Applicant's amendment (claims 9-29) and determined that the amendment to claim 9 would not be entered. Consequently, the Final Rejection remains proper. Further, contrary to Applicant's remarks and that indicated on the transmittal sheet filed September 7, 2004, a **complete copy** of the English language translation of the foreign priority document (DT 100 35 281.2, filed July 18, 2000) has not yet reached the file. Only claims 1-11, as identified above, have reached the instant application.


As set forth in 37 C.F.R. § 1.135(b), ***"[t]he admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment."*** [emphasis added]

Since expiration of the statutory period of sixth month period, from the mailing of the final rejection on May 3, 2004 had expired prior to the mailing of the notice of abandonment on March 15, 2005, the holding of abandonment is maintained and deemed to be proper.

The petition to withdraw the holding of abandonment is therefore **DENIED**.

It is noted that the instant application includes the filing of a petition to revive the application under 37 CFR § 1.137, filed August 30, 2005 as well as a request for continued examination filed on the same date. The application is being forward to the Office of Petitions to decide the petition filed under 37 CFR § 1.137.

Telephone inquiries should be directed to Special Programs Examiner Brian Johnson at (571) 272-3595.


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